REMARKS

In the Office Action[1] mailed July 18, 2006, the Examiner rejected claims 1-19 under 35 U.S.C. § 102(a) as being anticipated by Coutant, "64-Bit Application Development for PA-RISC & IA-64" ("*Coutant*"); rejected claims 1-19 under 35 U.S.C. § 102(b) as being anticipated by Microsoft, "Microsoft Interface Definition Language (MIDL): 64-Bit Porting Guide" ("*Microsoft*"); and objected to claim 20 as being dependent upon a rejected base claim.

By this Amendment, Applicants have amended claim 1 and 5. Based on the following remarks, Applicants respectfully traverse the rejection of claims 1-19 and request the timely allowance of all pending claims.

I. The *Coutant* document

The Examiner rejected claims 1-19 under 35 U.S.C. § 102(a). Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Examiner has not established that *Coutant* qualifies as prior art under 35 U.S.C. § 102(a). The *Coutant* document appears to be a printout of an electronic presentation and bears the date of March 17, 2000. According to the Examiner, "it is irrelevant whether or not the HP/Microsoft publication is not a printed (even though printable) publication because the statute says that if the invention was known..." (Office action at p. 2). However, the Examiner is incorrect.

To the extent the Examiner is applying *Coutant* as a "printed publication" within the meaning of § 102(a), Applicants remind the Examiner of the requirement for "a

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[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

<u>satisfactory showing</u> that such document has been <u>disseminated</u> or otherwise made <u>available</u> to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." M.P.E.P. § 2128 (emphasis added). Applicants also remind the Examiner that an electronic publication cannot be relied upon as prior art under § 102(a) if it does not include a publication date or retrieval date. In relevant part, the M.P.E.P. states, "[i]f the publication does not include a <u>publication</u> date (or <u>retrieval</u> date), it <u>cannot be relied upon</u> as prior art under 35 U.S.C. 102(a) or (b)" *See* M.P.E.P. § 2128 (emphasis added).

In this case, the Examiner has not established that the date of March 17, 2000, is relevant to the *Coutant*'s publication or retrieval. In the Office Action (at p. 2), the Examiner states that "[a]pplicants could refer to these companies/corporations for more information." However, unless <u>the Examiner</u> produces the requisite proof of *Coutant*'s dissemination and availability prior to Applicants' filing date (*See* M.P.E.P. § 2128), *Coutant* is not a competent prior art reference within the scope of 35 U.S.C. § 102(a) and cannot be used to reject Applicants' claims.

To the extent the Examiner is applying *Coutant* as being "known" within the meaning of § 102(a), Applicants remind the Examiner of the requirement of showing that this knowledge or use was available to the public. In the relevant part, M.P.E.P. states, "[t]he statutory language 'known or used by others in this country' (35 U.S.C. § 102(a)), means knowledge or use which is accessible to the public." (*See* M.P.E.P. § 2132). Accordingly, unless the Examiner produces the requisite proof that *Coutant*'s was <u>publicly known or used</u> prior to Applicants' filing date, *Coutant* is not a competent

prior art reference within the context of 35 U.S.C. § 102(a) and cannot be used to reject Applicants' claims.

Applicants respectfully remind the Examiner that, under 35 U.S.C. § 102, in order to properly establish that *Coutant* anticipates Applicants' claimed invention, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the... claims." *See* M.P.E.P § 2131 quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Even if *Coutant* were a proper reference under 35 U.S.C. § 102(a), which is not conceded by the Applicants, *Coutant* fails to anticipate claims 1-19 because *Coutant* does not disclose each and every element of these claims. Claim 1, as amended, recites a method including, for example,

> reading the interface file to <u>automatically generate a stub routine</u> that converts at least one of the integer and logical parameters from 32-bit to 64-bit and that <u>invokes the subprogram by specifying the converted parameters</u>. (emphasis added)

According to the Examiner, *Coutant* discloses the claimed step (Office action at p. 5). However, this is not correct. *Coutant* describes a 64-bit programming model and addresses porting to 64-bits, as well preparing code for 64 bits. *Coutant* compares the "ILP32" (integer, long, and pointer) and "LP64" programming models, noting that in "LP64," long and pointer types are 64 bits and that "LP64" includes certain extended derived types (*Coutant* at pp. 3-4). *Coutant* also compares aspects of 32-bit and 64-bit runtime environments, commenting that with 64-bit code "the compiler can inline the

import stubs" (pp. 5-6). *Coutant* also discloses accessing a "linkage table" in a program

for globals (*Coutant* at p. 11).

Although *Coutant* discloses comparing 32-bit and 64-bit programming models,

the cited document does not teach at least the "reading" feature of amended claim 1.

Because *Coutant* does not disclose the claimed step of "reading the interface file to

<u>automatically generate a stub routine</u> that converts at least one of the integer and

logical parameters from 32-bit to 64-bit and that <u>invokes the subprogram by specifying</u>

<u>the converted parameters</u>," *Coutant* does not disclose or suggest each and every

element recited in claim 1, as amended (emphasis added).

Claims 2, 17, and 18 depend from independent claim 1, the allowability of which

was established above. Claims 2, 17, and 18 are thus allowable at least due to their

dependence from claim 1. Claims 2, 17, and 18 recite unique combinations that are

neither taught nor suggested by prior art. Therefore, Applicants respectfully request

that the Examiner withdraw the rejection of claims 2, 17, and 18 under 35 U.S.C.

§ 102(a) and allow the claims.

Applicants respectfully traverse the rejection of claim 3 under 35 U.S.C. § 102(a)

as being anticipated by *Coutant*. The cited art fails to anticipate claim 3 because

Coutant does not disclose each and every element of the claim. Claim 3 recites a

combination including, for example,

> <u>automatically generating, based on the statements in</u>
> <u>the 32-bit interface file</u>, a 32-bit to 64-bit conversion stub that
> is used by the 32-bit source code to invoke 64-bit code.
> (emphasis added)

Although Coutant compares 32-bit and 64-bit programming models, the

reference does not teach at least "automatically generating" a 32-bit to 64-bit conversion

stub. Contrary to the Examiner's position (Office Action at p. 6), *Coutant*'s description of

a comparison of 32-bit and 64-bit runtime environments at pages 5-7 does not

constitute "automatically generating a 32-bit to 64-bit conversion stub," as claimed.

Because *Coutant* does not support the 35 U.S.C. § 102(a) rejection of claim 3, the

rejection legally deficient and should be withdrawn and the claim allowed.

Claims 4 and 19 depend from independent claim 3, the allowability of which was

established above. Claims 4 and 19 are therefore allowable at least due to their

dependency from claim 3. In addition, claims 4 and 19 recite unique combinations that

are neither taught nor suggested by prior art. Therefore, Applicants respectfully request

that the Examiner withdraw the rejection of claims 4 and 19 and allow the claims.

Applicants respectfully traverse the rejection of independent claim 5 under 35

U.S.C. § 102(a) as being anticipated by *Coutant*. The cited art fails to anticipate claim 5

because *Coutant* does not disclose each and every element of the claim. Claim 5

recites a combination including, for example,

> a stub generator that reads the interface file and that
> <u>automatically generates a stub for the subprogram</u> by using
> the characteristics, wherein the stub receives a set of
> parameter values, generates the values for the required
> parameters from the received set of parameter values, and
> invokes the subprogram with the values for the parameters;
> and a processor for running the interface generator and the
> stub generator. (emphasis added)

According to the Examiner, *Coutant*'s comparison of the "ILP32" and "LP64"

programming models discloses the claimed feature (Office Action at p. 7). However,

this is not correct. The Examiner alleged that in *Coutant* "the 'type' is identified as

characteristics for the developing of 32-bit code and 64-bit code in conversing/porting"

(Office Action at p. 8). Even if *Coutant* were to disclose parameter "characteristics," as

alleged by the Examiner, the document does not teach "a stub generator that reads the interface file and that <u>automatically generates a stub for the subprogram</u> by using the characteristics . . ." emphasis added).

Coutant merely compares "ILP32" and "LP64," noting that in "LP64" long and pointer types are 64 bits and also that "LP64" includes certain extended derived types (*Coutant* at p. 3-4). Furthermore, *Coutant*'s comparison of the 32-bit and 64-bit runtime environments (at pp. 5-6) does not constitute "a stub generator that reads the interface file and that <u>automatically generates a stub for the subprogram</u> by using the characteristics . . .," as recited in claim 5.

For at least these reasons, *Coutant* does not disclose or suggest each and every element recited in claim 5, as currently amended. The rejection of claim 5 under 35 U.S.C. § 102(a) is legally deficient and should be withdrawn and the claim allowed.

Claims 6-12 depend from independent claim 5, the allowability of which was established above. Claims 6-12 are therefore allowable at least due to their dependency from claim 5. In addition, claims 6-12 recite unique combinations that are neither taught nor suggested by prior art. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claim 6-12 and allow the claims.

Applicants also note the Examiner's assertions that certain features in claims 9-12 constitute "mere syntax of instruction/code used in major programming languages" (Office Action at p. 8). Applicants respectfully refer the Examiner to MPEP § 2144.03. In relevant part MPEP § 2144.03 states,

> "[i]f the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding."

Applicants submit that the Examiner has made a generalized statement regarding Applicants' claims without any documentary evidence to support it. Applicants traverse the Examiner's assertion, "noting the impropriety of this action, as the Federal Circuit has "criticized the USPTO's reliance on 'basic knowledge' or 'common sense' to support an obviousness rejection, where there was no evidentiary support in the record for such a finding." *Id.* Applicants submit that "[d]eficiencies of the cited references cannot be remedied by general conclusions about what is 'basic knowledge' or 'common sense.'" *In re Lee*, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain this rejection under 35 U.S.C. §102(a) after considering the reasoning presented herein, Applicants submit that the Examiner must provide "the explicit basis on which the examiner regards the matter as subject to official notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made," or else withdraw the rejection. *See* MPEP § 2144.03.

Independent claims 13 and 16, although of different scope, recite features similar to those of claim 3. As explained, the cited art does not support the rejection of claim 3 under 35 U.S.C. § 102(a). Accordingly, the cited art does not support the rejection of claims 13 and 16 for at least the same reasons set forth above in connection with claim 3.

Applicants respectfully traverse the rejection of claim 15 under 35 U.S.C. § 102(a) as being anticipated by *Coutant*. The cited art fails to anticipate claim 15 because *Coutant* does not disclose each and every element of the claim. Claim 15

recites a combination, including, for example "generating, based on the characteristics of the parameter, a stub routine that invokes the subprogram and that facilitates use of at least one of a converted integer and logical parameter" (emphasis added).

Contrary to the Examiner's position, *Coutant*'s comparison of the 32-bit and 64-bit runtime environments (at pp. 5-6) does not constitute "generating, based on the characteristics of the parameter, a stub routine that invokes the subprogram and that facilitates use of at least one of a converted integer and logical parameter," as claimed. In fact, Applicants respectfully submit that *Coutant* is silent regarding the "generating" feature of claim 15. For at least this reason, *Coutant* does not disclose or suggest each and every element recited in claim 15. The rejection of claim 15 under 35 U.S.C. § 102(a) is legally deficient and should be withdrawn and the claim allowed.

II. The *Microsoft* document

Regarding the *Microsoft* document, Applicants respectfully submit that the Examiner has not established the propriety of this document as prior art under 35 U.S.C. § 102(b). According to the Examiner, "because the statute says that if the invention was known - 102(a) - or in public use - 102(b) - then the invention is not patentable in view of these references" (Office Action at p. 2). The *Microsoft* document includes an "update" date of August 1999 and refers to a technical document, which includes a copyright date of 1998 (*Microsoft* at p. 18). Applicants respectfully submit that in case the Examiner is relying on the *Microsoft* document as a "printed publication," the Examiner must provide "a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested

and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." M.P.E.P. § 2128 (emphasis added).

Because the Examiner has not provided a "satisfactory showing" regarding the document's availability and has not established <u>public use</u> within the meaning of 35 U.S.C. § 102(b), the Examiner cannot rely on *Microsoft* as prior art within the scope of § 102(b). In the Office Action (at p. 2), the Examiner states that "[a]pplicants could refer to these companies/corporations for more information." However, unless <u>the Examiner</u> produces the requisite proof of *Microsoft*'s dissemination and availability more than a year prior to Applicants' filing date, the *Microsoft* document does not qualify as prior art under 35 U.S.C. § 102(b) and the rejection is thus improper.

Applicants respectfully remind the Examiner that, under 35 U.S.C. § 102, in order to properly establish that *Microsoft* anticipates Applicants' claimed invention, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the... claims." *See* M.P.E.P § 2131 quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Even if Microsoft were a proper reference under 35 U.S.C. § 102(b), which is not conceded by the Applicants, *Microsoft* fails to anticipate claims 1-19 because *Microsoft* does not disclose each and every element of these claims. Claim 1, as amended, recites a method including, for example,

> <u>adding to the interface file a directionality of at least</u>
> <u>one of the integer parameter</u> and the logical parameter
> based on comments in the source code; and

<u>adding to the interface file a parameter size</u> along
each dimension of at least one of the integer parameter and
the logical parameter. (emphasis added)

According to the Examiner, *Microsoft* discloses the claimed step (Office action at

p. 10). However, this is not correct. The *Microsoft* reference includes an "MIDL 64-bit

porting guide." This guide describes "new 64-bit features that can facilitate porting

application from 32-bit environments" (*Microsoft* at p. 1). The Examiner alleged that

Microsoft discloses "using MIDL as a programming language" for converting "32-bit to

64-bit" (Office Action at p. 10). The Examiner also relied on *Microsoft*'s disclosure

regarding "the syntax of subroutine calls and Handle Types of MIDL." However, the

Examiner provided no reference showing that *Microsoft* teaches "using MIDL as a

programming language" for converting "32-bit to 64-bit." Because *Microsoft* merely

discloses "features that can facilitate porting applications from 32-bit environments," it

does not teach or suggest each and every element recited in claim 1. The rejection of

claim 1 under 35 U.S.C. § 102(b) is legally deficient and should be withdrawn and the

claim allowed.

Claims 2, 17, and 18 depend from independent claim 1, the allowability of which

was established above. Claims 2, 17, and 18 recite unique combinations that are

neither taught nor suggested by prior art. Therefore, Applicants respectfully request

that the Examiner withdraw the rejection of claims 2, 17, and 18 and allow the claims.

Applicants respectfully traverse the rejection of claim 3 under 35 U.S.C. § 102(b)

as being anticipated by *Microsoft*. The cited art fails to anticipate claim 3 because

Microsoft does not disclose each and every element of the claim. Claim 3 recites a

combination including, for example,

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<u>automatically generating, based on the statements in</u>
the 32-bit interface file, a 32-bit to 64-bit conversion stub that
is used by the 32-bit source code to invoke 64-bit code.
(emphasis added)

Microsoft describes a 64-bit stub generation model and porting application from

32-bit environments. The *Microsoft* document also discloses a "compiler" generating a

stub for a given environment and describes a "dual stub," consisting of 32-bit and 64-bit

parts, for use in 32-bit and 62-bit environments (pp. 1 and 15). *Microsoft* describes

these "dual stub" files as a "convenient tool for porting" (p. 15). However, while the

Microsoft document discloses generating a "dual stub," which may facilitate porting, this

does not constitute "<u>automatically generating, based on the statements in the 32-bit</u>

<u>interface file</u>, a 32-bit to 64-bit conversion stub that is used by the 32-bit source code to

invoke 64-bit code," as claimed. Because *Microsoft* does not teach or suggest each

and every element recited in claim 3, the rejection of claim 3 under 35 U.S.C. § 102(b)

is legally deficient and should be withdrawn and the claim allowed.

Claims 4 and 19 depend from independent claim 3, the allowability of which was

established above. Claims 4 and 19 are therefore allowable at least due to their

dependency from claim 3. In addition, claims 4 and 19 recite unique combinations that

are neither taught nor suggested by prior art. Therefore, Applicants respectfully request

that the Examiner withdraw the rejection of claims 4 and 19 and allow the claims.

While not particularly addressed by the Examiner (*See* Office Action at p. 13),

Applicants respectfully traverse the rejection of independent claim 5 under 35 U.S.C.

§ 102(a) as being anticipated by *Microsoft*. The cited art fails to anticipate claim 5

because *Microsoft* does not disclose each and every element of the claim. Claim 5

recites a combination including, for example,

a stub generator that reads the interface file and that
<u>automatically generates a stub for the subprogram</u> by using
the characteristics, wherein the stub receives a set of
parameter values, generates the values for the required
parameters from the received set of parameter values, and
invokes the subprogram with the values for the parameters;
and a processor for running the interface generator and the
stub generator. (emphasis added)

The Examiner appears to rely on *Microsoft*'s "64-bit Stub Generation Model"

(Office Action at p. 13 and *Microsoft* at p. 15). As stated by the Examiner, *Microsoft*

discloses a "64-bit stub generation model" and a "porting" application from 32-bit

environments. *Microsoft* also discloses a "compiler" generating a stub for a given

environment and describes a "dual stub," consisting of 32-bit and 64-bit parts, for use in

32-bit and 62-bit environments (pp. 1 and 15). *Microsoft* describes these "dual stub"

files as a "convenient tool for porting" (p. 15).

However, while the *Microsoft* document discloses generating a "dual stub," which

may facilitate porting, this does not constitute a "stub generator that reads the interface

file and that <u>automatically generates a stub for the subprogram</u> by using the

characteristics, wherein the stub receives a set of parameter values, generates the

values for the required parameters from the received set of parameter values, and

invokes the subprogram with the values for the parameters," as recited in claim 5.

For at least this reason, *Microsoft* does not disclose or suggest each and every

element recited in claim 5, as currently amended. The rejection of claim 5 under 35

U.S.C. § 102(b) is legally deficient and should be withdrawn and the claim allowed.

Claims 6-12 depend from independent claim 5, the allowability of which was

established above. Claims 6-12 are therefore allowable at least due to their

dependency from claim 5. In addition, claims 6-12 recite unique combinations that are

neither taught nor suggested by prior art. Therefore, Applicants respectfully request

that the Examiner withdraw the rejection of claim 6-12 and allow the claims.

Applicants also note the Examiner's assertions that certain features in claims

7-12 constitute "mere syntax of instruction/code used in major programming languages"

(Office Action at pp. 13-14). Applicants respectfully refer the Examiner to MPEP

§ 2144.03. In relevant part, MPEP § 2144.03 states,

> "[i]f the examiner is relying on personal knowledge to
> support the finding of what is known in the art, the examiner
> must provide an affidavit or declaration setting forth specific
> factual statements and explanation to support the finding."

Applicants submit that the Examiner has made a generalized statement

regarding Applicants' claims without any documentary evidence to support it.

Applicants traverse the Examiner's assertion, "noting the impropriety of this action, as

the Federal Circuit has "criticized the USPTO's reliance on 'basic knowledge' or

'common sense' to support an obviousness rejection, where there was no evidentiary

support in the record for such a finding." *Id.* Applicants submit that "[d]eficiencies of the

cited references cannot be remedied by general conclusions about what is 'basic

knowledge' or 'common sense.'" *In re Lee*, 61 USPQ2d 1430, 1432-1433 (Fed. Cir.

2002), quoting *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain this rejection under 35 U.S.C. §102(b) after

considering the reasoning presented herein, Applicants submit that the Examiner must

provide "the explicit basis on which the examiner regards the matter as subject to official

notice and allow Applicants to challenge the assertion in the next reply after the Office

action in which the common knowledge statement was made," or else withdraw the

rejection. *See* MPEP § 2144.03.

Independent claims 13 and 16, although of different scope, recite features similar to those of claim 3. As explained, the cited art does not support the rejection of claim 3 under 35 U.S.C. § 102(b). Accordingly, the cited art does not support the rejection of claims 13 and 16 for at least the same reasons set forth above in connection with claim 3.

Applicants respectfully traverse the rejection of claim 15 under 35 U.S.C. § 102(b) as being anticipated by *Microsoft*. The cited art fails to anticipate claim 15 because *Microsoft* does not disclose each and every element of the claim. Claim 15 recites a combination, including, for example "generating, based on the characteristics of the parameter, a stub routine that invokes the subprogram and that facilitates use of at least one of a converted integer and logical parameter."

Contrary to the Examiner's position, the "64-bit stub generation model' in *Microsoft* does not disclose the "generating" step as recited in claim 15. *Microsoft* discloses a "compiler" for generating a stub for a given environment and describes a "dual stub," consisting of 32-bit and 64-bit parts, for use in 32-bit and 62-bit environments (pp. 1 and 15). *Microsoft* refers to these "dual stub" files as a "convenient tool for porting" (p. 15). Therefore, while the *Microsoft* document discloses generating a "dual stub," which may facilitate porting, this does not constitute the "generating" step as recited in claim 15. In particular, *Microsoft* does not disclose the step of "generating, based on the characteristics of the parameter, a stub routine that invokes the subprogram and that facilitates use of at least one of a converted integer and logical parameter" (emphasis added). For at least this reason, *Microsoft* does not disclose or
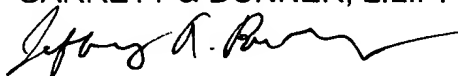
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suggest each and every element recited in claim 15. The rejection of claim 15 under 35

U.S.C. § 102(b) is legally deficient and should be withdrawn and the claim allowed.

In view of the foregoing amendments and remarks, Applicant respectfully

requests reconsideration and reexamination of this application and the timely allowance

of the pending claims.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 18, 2006   By: _____ #27,432

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